



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/604,598

08/01/2003

Eric Schneider

1597

24226 7590 01/22/2008
ERIC SCHNEIDER
1730 SOUTH FEDERAL HWY
#104
DELRAY BEACH, FL 33483

EXAMINER

PERRY, LINDA C

ART UNIT

PAPER NUMBER

4182

MAIL DATE

DELIVERY MODE

01/22/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/604,598 | Applicant(s) SCHNEIDER, ERIC | |
| | Examiner LINDA C. PERRY | Art Unit 4182 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is responsive to application 10/604,598 filed 8/1/2003. Claims 1-26 have been considered.

Priority

Examiner notes that applicant claims benefit of provisional application 60/319,448 and that the instant application includes claims, descriptive matter, and figures not in that provisional. Examiner acknowledges mention of Disclosure Document No. 496,673 no longer available, and notes that it may not be used to establish priority.

Specification

The disclosure is objected to because of the following informalities:

The specification contains errors too numerous to list. A sample of them follows

¶ [0004] 'Most recently MilePoint.com ...allows' should read 'Most recently MilePoint.com...has been allowing';

¶ [0007] 'metaphor to' should read 'metaphor for';

¶ [0008] 'educating ...of' should read 'educating...on' or 'educating... regarding';

¶ [0011] 'a alternate' should read 'an alternate';

¶ [0011] 'one of a generate should read 'one of generate'';

¶ [0021] 'an gas' should read 'a gas';

¶ [0022] 'an rewards' should read 'a rewards';

¶ [0023] 'an beverage' should read 'a beverage';

¶ [0069] 'are relate' should read 'are related';

¶ [0072] 'perform' should read 'performs';

¶ [0072] 'an request' should read 'a request'.

Art Unit: 4182

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6 -26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In particular, the method of claim 6 does not produce repeatable results because first time is when first amount is received and can, according to claim 7, be the time a network resource returns the first amount. The amount calculated is dependent on the first time and the first time can be governed by such things as variable network latency.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 7, the terms 'internal automation' and 'external automation' are vague and indefinite. Thus the scope of the claim is unclear.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-4 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. Claim 1 is for an account statement. It is directed to a judicial exception to 35 U.S.C. 101 (i.e., an abstract idea) and is not directed to a practical application of such judicial exception, because the claim does not require any physical transformation and the invention as claimed does not produce a useful, concrete, and tangible result.

A mere arrangement of printed matter, though seemingly a "manufacture," is rejected as not being within the statutory classes. See *In re Miller*, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969); *Ex parte Gwinn*, 112 USPQ 439 (Bd. App. 1955); and *In re Jones*, 373 F.2d 1007, 153 USPQ 77 (CCPA 1967).

Claims 2-4 do not resolve the deficiencies of claim 1. The details of the statement (claim 4), the sending of or request for the statement (claims 2 and 3) do not fall within a statutory category since they are neither a series of steps or acts to constitute a process, nor a mechanical device or combination of mechanical devices to constitute a machine, nor a tangible

Art Unit: 4182

physical article or object which is some form of matter to be a product and constitute a manufacture, nor a composition of two or more substances to constitute a composition of matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 6-8 and 15-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Iannacci (U.S. Patent Application Publication No. 2002/0062249 hereinafter referred to as Iannacci).

Regarding claim 6, Iannacci teaches *In a device having access to one of a memory and storage with a program stored therein (FIGs 1, 2), said program adapted to generate an amount (transactions ¶ [0447]-[0450]), a method comprising; receiving at a first time (aggregate over a period of time ¶ [0449]), a first amount (miles balance before transaction ¶ [0449]) corresponding to a second time (Dec. 29, 2000 ¶ [0449]); and, generating a second amount from said first amount, said first time, and said second time (credit miles, i.e. produce sum of prior mile balance plus the 674.415 miles of [0449]), wherein one of a first amount and second amount is representative of an amount that is not legal tender (miles ¶ [0449]).*

Regarding claim 7, Iannacci teaches *wherein said receiving said first amount corresponding to said second time includes receiving said first amount corresponding to said second time from one of a*

Art Unit: 4182

first data record, computer readable medium, machine readable code, internal automation, external automation, activation of a hyperlink, network resource redirection (network connection ¶ [0243]), and input (or input ¶ [0261]).

Regarding claim 8, Iannacci teaches *further including updating said first data record by replacing said first amount with said second amount and said second time with said first time (¶ [0239], [0449], and result of transaction appears on account statement ¶ [0448], [0449], and FIG.11).*

Regarding claim 15, Iannacci teaches *wherein said receiving said one of a first amount, first time, and second time from input includes inputting said one of a first amount, first time, and second time from a user interface element (¶ [0126]).*

Regarding claim 16, Iannacci teaches *wherein said inputting said one of a first amount, first time, and second time from a user interface element further includes inputting said one of a first amount, first time, and second time into one of a browser location field (Internet web site screen ¶ [0126]), text box, command line, speech to text interface, optical recognition interface, and magnetic recognition interface.*

Regarding claim 17, Iannacci teaches *wherein said first amount is a principal and said generating said second amount includes adding an interest to said principal (according to applicant's definition of interest including "an amount that is not legal tender paid for the use of money" [0038], depositing thirty seconds of audio (adding it to prior seconds accrued) in e-mail account for every \$10 purchase of gasoline ¶ [0261]).*

Regarding claim 18, Iannacci teaches *further including calculating said interest* (**¶ [0261]**, where \$20 of gasoline is bought, 60 seconds will be calculated).

Regarding claim 19, Iannacci teaches *wherein said calculating said interest includes calculating said interest from one of an interest rate and interest type* (thirty seconds for \$10 **¶ [0261]** is a fixed rate, simple interest, using applicant's definition of interest including "an amount that is not legal tender paid for the use of money" in [0038]).

Regarding claim 20, Iannacci teaches *wherein said interest rate is one of the group consisting of a fixed rate and variable rate and said interest type is one of the group consisting of a simple interest, compound interest, and continuous interest* (thirty seconds for \$10 **¶ [0261]** is a fixed rate, simple interest, using applicant's definition of interest including "an amount that is not legal tender paid for the use of money" in [0038]).

Regarding claim 21, Iannacci teaches *wherein the amount of time between said first time and said second time corresponds to one of a billing period* (period ending on **FIG. 13** or award start and end date on **FIG. 9**) *and interest period*.

Regarding claim 22, Iannacci teaches *wherein said first amount is of a first amount type and said second amount is of a second amount type* (**FIG. 11**, "amount " and "award type").

Regarding claim 23, Iannacci teaches *wherein said generating said second amount includes consulting an amount type conversion table for converting said first amount type to said second amount type* (**FIG. 11**, "current award" column).

Regarding claim 24, Iannacci teaches *wherein one of a first amount and second amount is one of an amount of product, amount of service, amount of reward, amount of points, amount of time, amount of space, amount of distance, amount of light, amount of mass, amount of volume, amount of storage, amount of bandwidth, and amount of energy (miles or award [0449])*..

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-5, 25, and 26 are rejected under 35 U.S.C. 103(a) as being anticipated by Wolfberg et al. (U.S. Patent No. 5,745,706 hereinafter referred to as Wolfberg) and further in

Art Unit: 4182

view of Iannacci (U.S. Patent Application Publication No. 2002/0062249 hereinafter referred to as Iannacci).

Regarding claim 1, Wolfberg teaches *an account statement comprising: and an account balance* (information including an account balance, **column 11 lines 11-39**) *wherein at least a portion of said account balance includes an account interest* (spending account and investment account **Abstract** , interest **column 5 lines 11-19, column 7 lines 25-38**) *and one of an account balance and account interest is representative of an amount that is not legal tender* (account management program includes allocation program **column 9 lines 35-48**, non-cash credits such as “frequent flier” miles or other products or services **column 10 lines 22-32**).

Wolfberg does not specifically teach a date on the account statement.

Iannacci shows an account balance *showing a date;... balance corresponding to said date* (it is likely that an account balance would include a date; consider Iannacci **FIGs. 14, 16, 18**, showing a statement date on the account statement).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the account statement as taught by Wolfberg to an account statement with a related date as taught by Iannacci. The motivation would be to provide a standard account statement.

Regarding claim 2, Wolfberg teaches *further including an account statement provider sending the account statement to an account holder of the account statement* (**column 11 lines 11-39**).

Regarding claim 3, Wolfberg teaches *further including an account holder requesting the account statement from an account statement provider* (**column 11 lines 11-19**).

Regarding claim 4, Wolfberg teaches *wherein the amount that is not legal tender is selected from a group consisting of an amount of product, amount of service, amount of reward, amount of points, amount of time, amount of space, amount of distance, amount of light, amount of mass, amount of volume, amount of storage, amount of bandwidth, and amount of energy (column 10 lines 22-28).*

Regarding claim 5, Wolfberg teaches *a computer program product comprising computer readable program code stored on a computer readable medium (FIG. 1, Abstract) the program code adapted to one of a generate, store, access, create, update, append, report, print, overwrite, send, forward, and distribute an account statement having ...an account balance (information including account balance, column 11 lines 11-39, or fixed sum and date certain column 5 lines 65 to column 6 line 11) corresponding to said date wherein at least a portion of said account balance includes an account interest (column 5 lines 11-19, column 7 lines 25-38) and one of an account balance and account interest is representative of an amount that is not legal tender(column 10 lines 22-32).*

Wolfberg does not specifically teach *an account statement having a date.*

Iannacci shows an account statement with a date (FIGs. 14, 16, 18).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the account statement as taught by Wolfberg to an account statement with a related date as taught by Iannacci. The motivation would be to provide a standard account statement.

Regarding claim 25, Wolfberg teaches *an apparatus comprising: a processor; one of a memory and storage in operative association with said processor (FIG. 1, Abstract, column 4 lines 1-10); means for receiving at a first time, a first amount corresponding to a second time (column 4*

Art Unit: 4182

lines 11-20); and, means for generating a second amount from said first amount, said first time, and said second time (**column 4 lines 42-53; column 9 line 63- column 10 line 11**), wherein one of a first amount and second amount is representative of an amount that is not legal tender (**column 10 lines 22-32**).

Regarding claim 26, Wolfberg teaches a computer program product comprising computer readable program code stored on a computer readable medium (**column 4 lines 34 – 53**), the program code adapted to execute the method for receiving at a first time, a first amount corresponding to a second time (**column 4 lines 11-20**), and generating a second amount from said first amount, said first time, and said second time (**column 4 lines 42-53; column 9 line 63- column 10 line 11**), wherein one of a first amount and second amount is representative of an amount that is not legal tender (**column 10 lines 22-32**).

Claims 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iannacci (U.S. Patent Application Publication No. 2002/0062249 hereinafter referred to as Iannacci), and further in view of Riley (U.S. Patent Application Publication No. 2002/0077940 hereinafter referred to as Riley).

Regarding claim 9, Iannacci teaches transaction amount appearing on account (¶ [0449]) but does not specifically teach form of record.

Riley teaches further including appending said second amount and said first time to said first data record (**Fig. 1**, items 25 and 28).

It would have been obvious to one of ordinary skill in the art at the time of the

Art Unit: 4182

invention to modify the program calculating account amounts as taught by Iannacci to adapt generation of specific record forms as taught by Riley. The motivation would be to provide a specific and standard description of the transaction to the users.

Regarding claim 10, Iannacci does not specifically teach form of record generated.

Riley teaches *further including generating from said first data record, a second data record having said second amount and said first time (Fig. 1, items 25 and 28).*

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the program calculating account amounts as taught by Iannacci to adapt generation of specific record amount and recording the time as taught by Riley. The motivation would be to provide a specific and standard description of the transaction to the users.

Regarding claim 11, Iannacci teaches *wherein one of a first data record, second data record, input, computer readable medium, and machine readable code corresponds to an account (amount will...appear on periodic payment account or collection/redemption account statement ¶[0447]-[0450]).*

Regarding claim 12, Iannacci teaches *wherein said account is one of the group consisting of a membership account, reward account (collection/redemption account ¶ [0449], [0054], and [0090]), prepaid account, checking account, savings account, investment account, retirement account, credit account, and debit account.*

Regarding claim 13, Iannacci teaches *wherein said account is issued from one of a bank and account provider (¶ [0054], current option supplier FIG. 11).*

Art Unit: 4182

Regarding claim 14, Iannacci teaches *wherein said account provider is one of a card provider (Visa, FIG. 11), subscription provider, service provider, utility provider, and phone provider.*

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Patents Number 4,742,457, 6,222,914, 5,025,372, 6,453,299, 7,051,925, 6,374,230, and Patent Application Publication Number 2002/0026423.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linda C. Perry whose telephone number is (571)270-1466. The examiner can normally be reached on 7:30AM-5PM Mon-Fri, Alt Fridays, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thu Nguyen can be reached on (571)272-6967. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 4182

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Signature:/Linda C Perry/

Examiner, Art Unit 4182

Name: Linda C. Perry

Date; 15 January 2008

/Thu Nguyen/

Supervisory Patent Examiner, Art Unit 4182